

Application No. 10/761,064  
Amendment and Response to Office Action  
Reply to Office Action mailed February 7, 2007

**AMENDMENTS TO THE DRAWINGS**

Please replace original sheets 1/3, 2/3, and 3/3 with the enclosed Replacement Sheets of like number. No new matter is included or added.

Attachment: Replacement Sheets 1/3, 2/3, and 3/3 (replacing original sheets 1/3, 2/3, and 3/3)

## **REMARKS/ARGUMENTS**

### **Claim Objections**

Claims 1-28 are objected to because they include reference numbers. Applicant has amended claims 1-28 to remove the internal reference numbering as suggested by the examiner. Withdrawal of the objection is respectfully requested.

### **Drawings**

The drawings are objected to under 37 CFR 1.83(b). Applicant respectfully asks that the objection be removed because the improved portion of the surgical microscope is so interconnected with old structure as to make separate views very difficult, and such views would not add to the reader's understanding (and may actually make the specification more difficult to understand).

The drawings are further objected to for failing to differentiate between light beam paths and control signal paths, failing to illustrate image data and control data, and failing to show sequence of movement of the signals. The amended Replacement Sheets are intended to overcome this objection. It is noted that electronic data signals are represented by a series of dots, an illumination beam path (light going to eye 1) is represented by dash-dot-dash etc., and the observation and camera beam paths (light coming from eye 1) are represented by a series of dashes. Arrows have been added to indicate signal flow.

It is now believed that the drawings completely and clearly represent the invention. Removal of the objection to the drawings is earnestly sought.

### **Claim Rejections - 35 USC § 112**

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, because "the imaging system" at line 3 lacks antecedent basis. Claim 12 is now amended to depend from claim 9, which affirmatively introduces "an imaging system." Removal of the rejection of claim 12 under 35 USC 112, second paragraph, is kindly sought.

### **Claim Rejections - 35 USC § 102**

Claims 1, 2, 4-7, 9, 10, 12-15, and 20-23 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,685,317 (Su et al.). Applicant respectfully overcomes the rejection by amending independent claims 1 and 23, as explained below.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628 (Fed. Cir. 1987); MPEP 2131.

Independent claims 1 and 23, as amended, require a camera beam path separated from an observation beam path by a beam splitter in the observation beam path (see beam splitter 7 in the present specification). The digital eye camera shown at Fig. 2 of Su et al. includes a beam splitter 32 used to direct corneally-reflected infrared light to an alignment infrared sensor 34 (see column 8, lines 12-23); beam splitter 32 does not split a camera beam path of the retinal diagnostic device (elements 15, 16, 17, 50, 19-24, 18) from the observation beam path of the microscope (elements 35-37). Rather, mirror 15 is movable into and out of the observation beam path to switch between the corneal mode and the retinal mode. See Su et al. at column 7, lines 23-27. Thus, beam splitter 32 of Su et al. does not correspond to the beam splitter set forth in amended claims 1 and 23.

Claims 2, 4-7, 9, 10, 12-15, and 20-22 depend from claim 1, and are thus also allowable. Favorable treatment of claims 1, 2, 4-7, 9, 10, 12-15, and 20-23 is respectfully requested.

### **Claim Rejections - 35 USC § 103**

Claims 3, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,685,317 (Su et al.). Claims 3, 8 and 11 depend from claim 1. Because claim 1 is allowable, as discussed above, claims 3, 8 and 11 are also allowable for the same reasons. Timely allowance of claims 3, 8 and 11 is courteously requested.

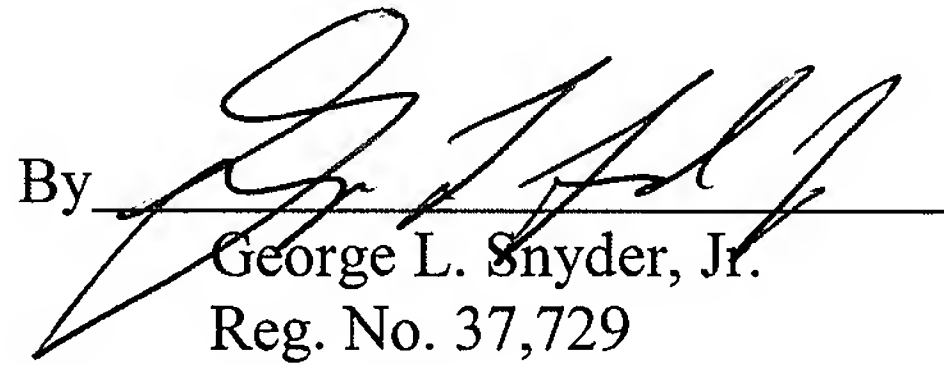
**Allowable Subject Matter**

Applicant gratefully acknowledges the indication of allowable subject matter in claims 16-19 and 24-26, and the allowance of claims 27-28. Because claim 1 (parent of claims 16-19) and claim 23 (parent of claims 24-26) are now thought to be in condition for allowance, claims 16-19 and 24-26 have not been rewritten in independent form.

**Conclusion**

Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested. The Examiner is authorized to charge any additional fees to deposit account number 08-2442.

Respectfully submitted,  
HODGSON RUSS LLP

By   
George L. Snyder, Jr.  
Reg. No. 37,729

GLS/  
Encs.

The Guaranty Building  
140 Pearl Street, Suite 100  
Buffalo, NY 14202-4040  
Tel: 716.856.4000  
Fax: 716.849.0349

Dated: August 6, 2007  
GLS/MAR/